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REMARKS

This amendment is presented in response to the office action mailed July 5, 2006 (the "office action"). In this paper, the specification was amended in various places. Also, certain claims were amended. The application contains claims 1-38. Applicant requests favorable reconsideration and allowance of all claims in the application.

OFFICE ACTION IS NON-FINAL

In the office action, the checkboxes in form PTO-326 identified the office action as being both Final and Non-Final. In a telephone interview that occurred on August 31, 2006 between attorney Dan Hubert (Reg. No. 33,906) and Examiner Nguyen, the Examiner confirmed that the office action is considered non-final.

HILTON DAVIS / FESTO STATEMENT

The claim amendments herein were not made for any reason related to patentability. Rather, these changes were implemented for various unrelated reasons. In the example of claim 11, "process" was changed to - -method- - to correct a clerical error. In the example of claims 19-20, "a" was changed to - -at least one- - to implement an improvement in form. In the example of claims 21 and 30, "a data schema" was deleted in order to remove an unnecessary limitation. In the remaining claims, as well as claims 19-20, certain amendments were made to make explicit what was already inherent to the claims, i.e., the nature of the claimed subject matter as being "computer-implemented."

35 USC 101 REJECTIONS : CLAIMS 1-38

These claims were rejected under 35 USC 101 as being directed to non-statutory subject matter.

The claims are patentable under section 101 because there is no *prima facie* case of unpatentability, as required by law. The burden is on the USPTO to

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set forth a prima facie case of unpatentability. Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility, IV. D.

Initially, it is clear that the claims fall within at least one of the four enumerated categories of patentable subject matter, that is, process, machine, manufacture, composition of matter. Claims 1-18, for example, concern a process. Claims 19-20 concern an article of manufacture. Claims 21-33 concern an apparatus.

None of the claims fall within a section 101 judicial exception, namely, laws of nature, natural phenomena, or abstract idea. Clearly, in the example of claim 1, there is no law of nature (e.g., E=mc2) or natural phenomenon (e.g., the law of gravity) involved since the invention concerns a "method for constructing a computer-implemented query system for use with a body of data." *See, e.g.,* Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility, IV. C. As for an "abstract idea," the exemplary claim 1 is anything but abstract. Rather, the claim abounds with tangible components, such as an operation of "providing multiple appearance templates each providing instructions for computer presentation of on-screen constructs to receive user input of query parameters" and "providing multiple subquery generators each comprising machine-executable code to prepare machine-executable query instructions applying a predetermined logical operation to the body of data."

There is a reflexive (but improper) temptation to conclude that anything concerning the operation of a computer is abstract, since these goings on are largely invisible, other than their output or result. To the operator of an automobile, the operation of the engine is invisible, other than its output of noise, vibration, and acceleration. Still, no one would assert that the operation of a gasoline combustion engine is abstract. When the operation of the computer is scrutinized in greater detail, like the gasoline combustion engine, there is an abundance of specific, tangible, technology that is anything but abstract.

Phenomena of nature (though just discovered), mental processes, and abstract intellectual concepts are not patentable because they are the basic tools of scientific and technological work. *See, e.g.,* Interim Guidelines for

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Examination of Patent Applications for Patent Subject Matter Eligibility, IV. C. 3. This rationale does not apply to the present invention. The specifically claimed process for constructing a computer-implemented query system (in the example of claim 1) is not the basic tool of scientific and technological work. Rather, this invention involves significant complexity, and represents a significant advancement in utility and underlying technology. There is absolutely nothing to suggest or disclose that the claimed invention is a basic tool of scientific and technologic work.

Accordingly, the example of claim 1 sets forth abundantly patentable subject matter. The remaining claims are patentable for similar reasons. The *prima facie* case of unpatentability case is incomplete.

The *prima facie* case of unpatentability is also incomplete for another reason. If an examiner determines that the claimed invention preempts a 35 USC 101 judicial exception, the examiner must identify the abstraction, law of nature, or natural phenomenon and explain why the claim covers every substantial practical application thereof. Interim Guidelines for Examination of Patent applications for Patent Subject Matter Eligibility, IV. C. 3. In the present case, the office action does not identify any suggested abstraction, law of nature, or natural phenomenon and explain why the claim covers every substantial practical application thereof.

To the contrary, the claimed invention does not concern an abstract idea at all. Rather, there is a real-world act of providing a computer-implemented system that performs queries upon data, providing a useful, concrete, and tangible result. In today's world, there has been an intense proliferation of electronic data. Data abounds on the worldwide web, corporate Intranet, individual's personal computers, government databases, and other sources. Without mechanisms to effectively perform queries upon this data, the data itself is useless. And, even though the millions of ones and zeros that form this data is invisible to the eye, the operations performed upon this data are still real-world acts. Daily, people perform worldwide web searches with search engines. People query and search companies' vast product catalogs in order to shop and

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make purchases. Government employees and members of the public search immense patent databases of prior art to conduct novelty and infringement searches of technology. Clearly, actions such as constructing a system to perform computer implemented queries of data, and such systems themselves, are not abstract ideas. Rather, they are practical applications involving real world technology. *State Street Bank & Trust Co. v. Signature Financial Group Inc*, 149 F.3d 1368, 1374, 47 USPQ2d 1596, 1601 (Fed. Cir. 1998).

As such, the pending claims are allowable under 35 USC 101 and the application should be allowed.

FEES

The Commissioner is authorized to charge any fees due to the Glenn Patent Group Deposit Account No. 07-1445, Customer No. 22862. Applicant considers this document to be filed in a timely manner.

Respectfully Submitted,

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